

REMARKS

As may be appreciated from the above listing of claims, the claims have also been amended herein. The claims were amended by cancelling the previously presented claims and providing new claims 33-51. No payment of fees for the amended claims is required for the amendment. A payment for a two month extension of time is provided with this Amendment. Further, authorization is provided herewith to pay any underpayment of fees or credit any overpayment of fees to Deposit Account No. 02-4800.

I. **RESPONSE TO ENABLEMENT REJECTION OF THE PREVIOUSLY PRESENTED CLAIMS**

The Examiner rejected previously presented claims 13-25 and 30-32 as not being enabled in the Office Action dated April 14, 2009 (hereafter "the Office Action"). However, the Examiner has failed to provide a sufficient explanation as to why the claims are not enabled to support the rejection of these claims. Further, as may be appreciated by the evidence of enablement provided herewith, the claims clearly are enabled.

A. **Burden Of Proof For An Enablement Rejection**

"Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention." MPEP § 2164.01. "The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable?" MPEP § 2164.01. "That standard is still the one to be applied." MPEP § 2164.01 (citing *In re Wands*,

858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988)). "A patent need not teach, and preferably omits, what is well known in the art." MPEP § 2164.01 (citing *In re Buchner*, 929 F.2d 660, 661, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991)). "Any part of the specification can support an enabling disclosure, even a background section that discusses, or even disparages, the subject matter disclosed therein." MPEP § 2164.01

"Before any analysis of enablement can occur, it is necessary for the examiner to construe the claims." MPEP § 2164.04. "For terms that are not well-known in the art, or for terms that could have more than one meaning, it is necessary that the examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action." MPEP § 2164.04(citing *Genentech v. Wellcome Foundation*, 29 F.3d 1555, 1563-64, 31 U.S.P.Q.2d 1161, 1167-68 (Fed. Cir. 1994)).

"In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." MPEP § 2164.04 (emphasis added) (citing *In re Wright*, 999 F.2d 1557, 1562, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993) (explaining that an examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure)).

"A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms that correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied

on for enabling support." MPEP § 2164.04 (emphasis added). Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 U.S.P.Q. 367, 370 (CCPA 1971). "As stated by the court, 'it is incumbent upon the Patent Office, whenever a rejection on this basis is made, **to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.** Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.'" MPEP § 2164.04 (quoting *In re Marzocchi*, 439 F.2d at 224, 169 U.S.P.Q. at 370).

In the event doubt may arise about enablement because information is missing about one or more essential parts or relationships between parts which one skilled in the art could not develop without undue experimentation, **the examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation.** MPEP § 2164.04; *see also* MPEP § 2164.06(a). **Specific technical reasons are always required to support a rejection based on the enablement requirement.** MPEP § 2164.04.

B. The Claims Are Enabled

The Examiner rejected previously presented claims 12-25 and 30-32 as not being enabled. (Office Action, at 2). The enablement rejection was not adequately asserted. For instance, the Examiner has failed to provide any technical reasons as to why the claims lack enablement. Instead, the Examiner has merely provided conclusory statements with no

reasoning to support those statements. To the contrary, a review of the specification shows that the claims are clearly enabled.

The Examiner also objected to the use of various terms in the claims as lacking enablement. The enablement of these claim terms are discussed below.

1. Tunneling Is Enabled

The Examiner found that the "tunneling" term was not enabled by the specification because one of ordinary skill in the art would not know how to do "tunneling."

The specification clearly discusses tunneling and examples of how to conduct "tunneling" at paragraphs 50 and 51. Further, art cited by the Examiner also discusses such tunneling, such as the ITU-T reference and U.S. Patent Application Publication No. 2005/0088977. Indeed, one of ordinary skill in the art would clearly know how to perform "tunneling." The prior art shows that one of ordinary skill in the art knows how to conduct "tunneling." Further, the specification teaches one of ordinary skill in the art how "tunneling" may be performed in connection with an embodiment of the claimed invention. Therefore, this enablement rejection should be withdrawn.

2. "Private" Is Enabled

The Examiner has found that the term "private" in claim 15 is not enabled in the specification. To the contrary, a private network, such as a private data transfer network, was well known to those of ordinary skill in the art at the time of the invention. One example of a "private" network is a corporate intranet that is only accessible by company employees.

The Wikipedia entry for "private network" and one definition of "private network" that are provided herewith clearly show this term has a well understood meaning in the art. Further,

the specification and the prior art, such as U.S. Patent Nos. 4,348,554, 5,455,855, 6,055,575, 6,226,751, and 6,496,867 use the term "private" in connection with networking and also show that one of ordinary skill in the art would understand what a private network is and how one may be created.

3. Operating Data Packet Is Enabled

The Examiner also objected to the term "operating data packet" and stated that this term is not adequately disclosed in the specification. To the contrary, this term is specifically used and discussed in paragraph 31 of the specification. The specification clearly states that an operating data packet may be a signaling message that relates to signaling for the transfer of voice data or for the performance of an additional service feature with the transfer of voice data. For instance, a signaling message that includes voice data and also includes a service feature such as forwarding of a call, a conference circuit, or a call-back when busy data may be an operating data packet. The specification sufficiently describes the "operating data packet" term for one of ordinary skill in the art to know what that term refers to, what types of data packets may be considered "operating data packets," and how to make data packets that are "operating data packets."

II. RESPONSE TO INDEFINITE REJECTIONS

The Examiner rejected previously presented claims 13-25 and 30-32 under 35 U.S.C. § 112 as being indefinite in the Office Action. (Office Action, at 5-8). These claims have been canceled and replaced by new claims 33-51. the new claims meet the requirements of 35 U.S.C. § 112.

A. Burden Of Proving Indefiniteness

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. MPEP § 2173.02. **Only when a claim remains insolubly ambiguous without a discernible meaning after all reasonable attempts at construction must the claim be declared indefinite.** MPEP § 2173.02.

If the language of a claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph, would be appropriate. MPEP § 2173.02. However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant. MPEP § 2173.02.

"The test for definiteness under 35 U.S.C. 112, second paragraph, is whether those skilled in the art would understand what is claimed when the claim is read in light of the specification." MPEP § 2173.02. "If one skilled in the art is able to ascertain in the example above, the meaning of the terms 'suitable liquid' and 'solids of a filtering agent' in light of the specification, 35 U.S.C. 112, second paragraph, is satisfied." MPEP § 2173.02. "If upon review of the claim as a whole in light of the specification, the examiner determines that a rejection under 35 U.S.C.

112, second paragraph, is not appropriate in the above-noted example, but is of the opinion that the clarity and the precision of the language can be improved by the deletion of the phrase 'such as' in the claim, the examiner may make such a suggestion to the applicant." MPEP § 2173.02. "If applicant does not accept the examiner's suggestion, the examiner should not pursue the issue." MPEP § 2173.02.

Breadth of a claim is not to be equated with indefiniteness. MPEP § 2173.04 (citing *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971)). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. MPEP § 2173.04.

B. The Pending Claims Are Definite

The Examiner has asserted that the previously presented claims were indefinite because the claims fail to describe "how" some limitation of the claim performs some kind of function. For instance, the Examiner has found claim 13 to be indefinite because it fails to describe "how" tunneling is performed through a network access device. (Office Action, at 6). This is an inappropriate basis for an indefiniteness rejection. The claims need to inform one of ordinary skill in the art what the metes and bounds of a claim are. The claims need not explicitly explain how some function is performed by or through a device. MPEP §§ 2173.02, 2173.04. This is the role of the specification, which provides examples of how such functions can be performed in the present application.

If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from

that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

MPEP § 2173.04. Here, the claims clearly articulate the scope of the claims.

For instance, the Examiner has not objected to not knowing what a particular feature or device is or what device is being referenced to in the claim. To the contrary, the Examiner has asserted that it is unclear "how" some device does something. Such argument seeks to improperly require an explanation of how a functional limitation is performed within a claim. Indefiniteness is an improper basis for such a rejection. *See* MPEP § 2173.05(g).

Indeed, a "functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." MPEP § 2173.05(g) "A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step." MPEP § 2173.05(g). For instance, "[i]t was held that the limitation used to define a radical on a chemical compound as "incapable of forming a dye with said oxidizing developing agent" although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought." MPEP § 2173.05(g) (citing *In re Barr*, 444 F.2d 588, 170 U.S.P.Q. 33 (CCPA 1971)).

The claim limitations objected to by the Examiner are similar to the limitations at issue in *In re Barr*. In fact, the Examiner has indicated the claims are clear and distinct. For instance, the Examiner has provided a statement as to how he will treat limitations recited in the rejected claims in the Office Action. If the claims were indefinite, the Examiner would be unable to make such a determination. The Examiner clearly can understand the metes and bounds of the

claims. A person of ordinary skill in the art can also understand what is claimed when the claim is read in light of the specification. The new claims presented here are definite.

1. The Objected To Claim Terms Are Definite

The Examiner specifically objected to the terms "tunneling" and "operating data packet." These terms are both properly set forth in the specification, as discussed above with reference to the enablement rejection issued in the Office Action.

For instance, tunneling is described in paragraphs 50 and 51 of the specification. Further, one of ordinary skill in the art would understand what the term "tunneling" refers to. In fact, the ITU-T reference and U.S. Patent Application Publication No. 2005/0088977 cited by the Examiner discusses examples of tunneling in great detail. Therefore, this term is clear to one of ordinary skill in the art.

An "operating data packet" is also discussed in the specification at paragraph 31. An "operating data packet" is a data packet that relates to the signaling for the transfer of voice data or the performance of additional service features, such as forwarding of a call, a conference circuit, or a call-back when busy, with the transfer of voice. This term is clearly referenced in paragraph 31 of the specification and also clearly described for one of ordinary skill in the art to understand the meaning of this claim term.

For at least the above reasons, the indefiniteness rejection should be withdrawn. "Tunneling" and "operating data packet" as used in the new claims presented here are definite. These terms are discussed in the specification sufficiently for one of ordinary skill in the art to understand what they mean. In fact, these terms were well understood by those of ordinary skill

in the art at the time of the invention, as may be appreciated from the specification and the prior art.

2. Antecedent Basis Issues

The Examiner also identified certain terms that supposedly lacked antecedent basis in the Office Action. The amended claims provide antecedent basis for the claim terms.

III. RESPONSE TO THE OBVIOUSNESS REJECTION OF THE PREVIOUSLY PRESENTED CLAIMS

The Examiner also rejected previously presented claims 13-25 and 30-32 as being rendered obvious in the Office Action. (Office Action, at 8).

Claims 13, 15-19, 21 and 23-24 were rejected in view of the combination of European Patent No. EP 0 926 909 to Mayeul et al. in view of ITU-T ("H.323 Annex M.1 Tunneling of signaling protocols (QSIG) in H.323", 11/2000, International Telecommunication Union, pages 3, 6 and 7) (hereafter "ITU-T") and U.S. Patent Application Publication No. 2004/0032881 to Arai.

Claims 14 and 25 were rejected in view of the combination of Mayeul et al., ITU-T, Arai and U.S. Patent Application Publication No. 2005/0088977 to Roch et al. (Office Action, at 19).

Claims 20 and 22 were rejected in view of the combination of Mayeul et al., ITU-T, Arai and U.S. Patent No. 7,136,372 to Nilsen. (Office Action, at 20)

Claims 30 and 32 were rejected in view of the combination of Mayeul et al., and Arai. (Office Action, at 22).

Claim 31 was rejected in view of the combination of Mayeul et al, Arai and U.S. Patent Application Publication No. 2002/0041576 to Chang et al. (Office Action, at 27).

The claims have been amended by canceling the previously presented claims and providing new claims 33-51. As discussed below, new claims 33-51 are allowable over the cited art.

A. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, **all the limitations of the claims must be considered and given weight.**" MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]jections on

obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" MPEP § 2143.01 (citing *KSR*, 550 U.S. at ___, 82 U.S.P.Q.2d at 1396) (emphasis added).

For instance, an invention that permits the omission of necessary features and a retention of their function is an indicia of nonobviousness. *In re Edge*, 359 F.2d 896, 149 U.S.P.Q. 556 (CCPA 1966); MPEP 2144.04. A conclusory statement to the contrary is insufficient to rebut such an indicia of nonobviousness. *See* MPEP § 2143.01.

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

B. Arai Is Not Prior Art

As may be appreciated from the attached declaration, Arai is not prior art. Arai was filed on August 16, 2002. The present application has a priority date of September 5, 2002. The declaration provided herewith makes it clear that the claimed invention was conceived prior to August 16, 2002. Therefore, Arai is not prior art under 35 U.S.C. § 102 and cannot be used as a basis for rejecting any claims of the present application. *See* MPEP §§ 706.02(b), 715.

C. Claims 33-44 Are Allowable Over The Cited Art

Claim 33 requires that a signaling message in a first protocol be converted to a second protocol if the signaling message is in a protocol that is different from the protocol recognized by

a destination device. Claims 34-44 depend directly or indirectly from claim 33 and, therefore, also require such a conversion of different protocols. The Examiner has argued that Mayeul et al. disclose or suggest a protocol converter. (Office Action, at 11). To the contrary, Mayeul et al. only disclose a conversion device of a node that is configured to convert operational identifiers.

Mayeul et al. teach that an operational identifier is information that identifies a particular operation. (§ 19). For instance, an identifier IV may identify a first service SS1 and an identifier OI may identify a second service. (§ 19). Some nodes within a network may recognize different identifiers as representing, or identifying, different services. For instance, one node may be configured to recognize IV as identifying the first service while other nodes within that same network may recognize IV as identifying the second service. The node 22 disclosed by Mayeul et al. includes a converter that converts the object identifiers within a message. Such a conversion of object identifiers is not a conversion of protocols for signaling messages.

Mayeul et al. merely teach that a node may be configured to convert an object identifier within a message from one value to another value so that the proper service is communicated. There is no protocol conversion taught or suggested by Mayeul et al. If a message in Mayeul et al. were thought of as a language, one could view Mayeul et al. as teaching the adjustment of a word in a sentence that initially read "use knob" to "use handles." So a conversion would take place by a node so that one device that knew knob to be a knob could communicate the use of knobs to a device that only knows knobs as being handles.

In contrast, a protocol can be considered the format that defines the code to use and where to place that code in a signaling message. For instance, the ITU-T reference discloses

tunneling signaling protocols for use with one type of protocol, the H.323 protocol. This protocol requires the use of code in a certain format and in a certain arrangement to be properly read. If a protocol is thought of as a language, the translation of French to English is akin to the conversion of one protocol to another protocol. This is significantly different from the conversion process disclosed by Mayeul et al.

1. Mayeul et al. Teach Away From Claims 33-44

Mayeul et al. teach the use of a node that converts a message using a particular protocol such that an object identifier within that message is changed. The protocol of the message, however, remains unchanged. Indeed, Mayeul et al. teach or suggest a conversion or change of protocol in any message.

At Paragraph 3, Mayeul et al. state that object identifiers are configured to be given an integer value (IV) or a name (OI) in different formats. The conversion device disclosed by Mayeul et al. merely converts the integer value object identifier to the name or vice versa. (¶¶ 19-21). This is not a change in protocol in any way. To the contrary, the conversion of an object identifier taught by Mayeul et al. is merely a change to a portion of a message in a particular protocol. The protocol itself stays the same. Consequently, Mayeul et al. teach away from the invention, which requires a protocol conversion for a signaling message in a protocol that is different than the protocol recognized by a destination device.

**2. Any Combination Of The Cited Art Cannot
Render Claims 33-44 Obvious**

The Examiner has only cited Mayeul et al. as teaching or suggesting a protocol conversion. As discussed above, it is clear that Mayeul et al. do not teach or suggest such a protocol conversion. Indeed, the Examiner has only relied upon Mayeul et al. as making such a

disclosure. Therefore, the combination of references cited by the Examiner fails to teach or suggest each and every limitation of claims 33-44 and, therefore, these claims are allowable over the cited references.

D. Claims 45-51 Are Allowable Over The Cited Art

Claim 45 requires a device to include a protocol conversion device that is configured to convert a signaling message having a first signaling protocol to a converted signaling message having a second signaling protocol that is different than the first signaling protocol. Claims 46-51 depend directly or indirectly from claim 45 and, therefore, also contain these limitations.

As discussed above with reference to claims 33-44, Mayeul et al. do not teach or suggest any device that is capable of converting a signaling message from a first protocol to a second protocol. Nor does any of the other art cited by the Examiner teach or suggest such a protocol conversion. Thus, the combination of the cited art cannot teach each and every limitation of claims 45-51. Therefore, claims 45-51 are allowable over the cited art.

E. Granted European Patent No. EP 1 535 477 Shows The Pending Claims Are Allowable

The present application corresponds to granted European Patent No. EP 1 535 477. For the Examiner's reference, a copy of this patent is provided herewith. The European Patent Office has found the invention disclosed in the present application to warrant patent protection. This is an indicia of the non-obvious nature of the pending claims and shows that the claims should be allowed.

IV. CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims is respectfully requested.

Respectfully submitted,

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Dated: August 26, 2009

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